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OFFICE OF PETITIONS

In re Application of	:
Chun-Te Yu	:
Application No. 10/671,659	: DECISION ON PETITION
Filed: September 29, 2003	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. EL-CFP00414	:

This is a decision on the petition, filed December 14, 2005 (and again on December 15, 2005), which is being treated as a petition under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application Application No. 60/443,331, filed January 29, 2003).

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(6).

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Firstly, the petition lacks compliance with item (1) above. In this regard, the petition is not accompanied by a reference to the prior-filed application in an amendment to the first line of the specification, following the title, or by reference in an Application Data Sheet (ADS) in accordance with 37 CFR 1.76(a)(5). The amendment to include the prior-filed application in the first line of the specification cannot be a physical part of a petition, but must comply with the provisions of 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate

physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office. Accordingly, a proper reference to the prior-filed application has not been submitted.

Secondly, it is noted that the inventor in provisional Application No. 60/443,331, the application to which priority is now sought, sets forth Cory O. Nykoluk as the sole inventor. The present application names Chun-Te Yu as the sole inventor. 37 CFR 1.78(a)(4) states:

In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

Therefore, for the further reason that there is no common inventor in either the provisional application or the present nonprovisional application, it would be improper to grant the petition to accept the late claim for priority to the provisional application. *See* 37 CFR 1.48 for correction of inventorship in a patent application.

It is noted that duplicate fees for the instant petition were assessed to petitioner's credit card (possibly because of the duplicate filing of the petition). Accordingly, the duplicate \$1,370 fee will be credited back to petitioner's credit card in due course.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.


Frances Hicks
Petitions Examiner
Office of Petitions